



[10191/3705]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Application of:

Andreas FINK et al.

For: FASTENING ASSEMBLY

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Serial No.: 10/524,811

: Examiner: David C. REESE

: Art Unit: 3677

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AARON C. DEBITCH

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

SIR:

Appellant submits the present Reply Brief (the two-month response date for which is August 9, 2010 (since August 8, 2010 is a Sunday) in response to the Examiner's Answer dated June 8, 2010 ("the Answer").

It is respectfully submitted that the final rejections of claims 9 to 11, 13 to 17, and 19 to 26 should be reversed, and these claims should be allowed for the reasons explained herein.

Finally, the Office is again encouraged to contact the undersigned if there are any questions as to any matters.

ARGUMENT

A. REJECTIONS UNDER 35 U.S.C § 102(B) OF CLAIMS 9 to 11, 13, 14, 17, 19, 22, 23 and 26

CLAIMS 9 to 11, 13, 14, 17, 19, 22, 23 & 26

Claims 9 to 11, 13, 14, 17, 19, 22, 23, and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,309,132 (“Jakob”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Answer and the Office Actions to date does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Answer and the Office Actions to date may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Independent claim 9 is to “a self-locking bolt” and includes the features of “engagement surfaces for a tool at an end of the shank, ***in which the head has a bottom surface connecting the head to the shank and a top surface that is round and smooth.***” The Office conclusorily maintains that the head (38) has a bottom surface (bottom of 38) connecting the head (38) to the shank and a top surface (top of 38) that is round and smooth (the bottom of 38 connects the head to the shank and the top of 38 is round and smooth).

First, it is respectfully submitted that the surface described by the Answer and the

Office Actions to date is not the surface of the claimed subject matter. Further, the “top” surface of Jakob cannot be identically described as having a smooth surface, as provided for in the context of the presently claimed subject matter, because it has a *hexagonal shaped tool* interface protruding out of it.

In this regard, the online dictionary selected by the Office states that the word “smooth” has a first definition of “free from projections or unevenness of surface; not rough.” (<http://wordnet.princeton.edu/perl/webwn?s=smooth>). The surface of the head, which is not attached to the shank, is clearly not “free from projections,” as the tool interface is projecting from it. Thus, neither surface of “Jakob” is a “smooth surface” as provided for in the context of claim 9.

It is respectfully submitted that the Answer and the Office Actions to date essentially ignore the proper meanings of the terms, like “top surface” and “smooth” – which are to be understood in view of the specification. The Office again essentially ignores the reasonable interpretation of the above-discussed terms and features, as provided for in the context of the claimed subject matter, and as would be understood by a person having ordinary skill in the art based on the specification. (See *In re Weiss*, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must “look to the specification for the meaning ascribed to that term”; Board reversed) (unpublished decision); *In re Okuzawa*, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) (“claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation”; Board reversed; emphasis in original) (citing *In re Royka*, 180 U.S.P.Q. 580, 582-83 (C.C.P.A. 1974) (claims are “not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part”; Board reversed; emphasis in original); and *In re Rohrbacher*, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an “applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification”; Board reversed)).

It is respectfully submitted that this is exactly the case here since contrary to the foregoing law, the Answer and the Office Actions to date simply reflects its own unreasonable reading of the discussed terms. Indeed, the Office has yet to explain how the top surface -- with a hexagonal shaped tool interface protruding out of it -- is somehow “smooth.” Instead, the Office asserts that “though it is apparent that the top surface of 38 does indeed have a

hexagonal shaped tool interface protruding out of it, this interface, however, does not preclude the other are of the top surface ... from being round and smooth; rather, ... there is a good amount of top surface of 38 where there is no interface and which can and is considered round and smooth.” (*Advisory Action*). Thus, although the Office essentially concedes that the top surface is not round and smooth but *hexagonal* in shape, it still unreasonably maintains that it is round and smooth.

The Answer indicates that surfaces 24 and 38 are confused in the Brief, but the Examiner and the Briefs make plain that it is surface 38 that is discussed. Accordingly, the Answer is not understood as to its specific assertions in this regard.

If the tool interface is considered affixed to the top surface (e.g., not part of the top surface), then the top surface is clearly not “smooth,” as a large tool interface is protruding out of it. If the tool interface is considered part of the top surface, then the top surface is clearly not “smooth,” as the six hexagon edges protrude from the interface shape.

Accordingly, “Jakob” does not identically disclose (nor even suggest) all of the above-discussed features of claim 9, as presented, so that it is allowable, as are its dependent claims.

**B. REJECTIONS UNDER 35 U.S.C § 103(A)
OF CLAIMS 15, 16, 20, 21, 24 & 25**

CLAIMS 15, 16, 20, 21, 24 and 25

Claims 15, 16, 20, 21, 24 and 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over “Jakob” in view of EP 0747604 (“Spurr”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 15, 16, 20, 21, 24 and 25 depend from claim 9, and are therefore allowable for at least the same reasons as claim 9, since any review of the secondary reference makes plain that it does not cure -- and it not asserted to cure -- the critical deficiencies of the primary reference.

As still further regards all of the obviousness rejections of the claims, it is respectfully submitted that a proper *prima facie* case has not been made in the present case for obviousness, since the Office Actions to date never made any findings, such as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made. (*See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998) (the “factual predicates underlying” a *prima facie* “obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art”)).

It is respectfully submitted that the proper test for showing obviousness is what the “combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art”, and that the Patent Office must provide particular findings in this regard — the evidence for which does not include “broad conclusory statements standing alone”. (*See In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) (obviousness rejections reversed where no findings were made “concerning the identification of the relevant art”, the “level of ordinary skill in the art” or “the nature of

the problem to be solved”))). It is respectfully submitted that there has been no such showings by the Office Actions to date or by the Advisory Action.

In fact, the present lack of any of the required factual findings forces both Appellants and this Appeals Board to resort to unwarranted speculation to ascertain exactly what facts underly the present obviousness rejections. The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (See *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (See *In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Withdrawal of the obviousness rejections of 15, 16, 20, 21, 24 and 25 is therefore respectfully requested.

It is therefore respectfully requested that all rejections of the pending claims be withdrawn.

CONCLUSION

In view of the above, it is respectfully requested that the rejections of claims 9 to 11, 13 to 17, and 19 to 26 be reversed, and that these claims be allowed as presented.

Dated: _____

8/9/2010

Respectfully submitted,

By: _____

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